

03/16/99

Office Action Summary

Application No.
08/963,299

Applicant(s)
Chao et al.

Examiner
HUNG DANG

Group Art Unit
2515



☒ Responsive to communication(s) filed on Dec 22, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-3, 5, 8-20, 22, 26-30, 33-37, and 40-47 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3, 5, 8-20, 22, 26-30, 33-37, and 40-47 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 10

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2873

1. The amendment filed on 12/22/98 has been entered.

Information Disclosure Statement

2. The Information disclosure Statement filed on 2/1/99 has been considered.

Claims Rejection, Obviousness Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2873

Claims 1-3, 5, 8-20, 22, 26-30, 33-37 and 40-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 5,737,054. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention in claims 1-3, 5, 8-20, 22, 26-30, 33-37 and 40-47 of this application is substantially the same as that in claims 1-4 of U.S. Patent No. 5,737,054. All the limitations in claims 1-3, 5, 8-20, 22, 26-30, 33-37 and 40-47 of this application is included in claims 1-4 of U.S. Patent No. 5,737,054 and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention in claims 1-3, 5, 8-20, 22, 26-30, 33-37 and 40-47 of this application is substantially identical to claims 1-4 of U.S. Patent No. 5,737,054. Although claims 1-3, 5, 8-20, 22, 26-30, 33-37 and 40-47 of this application does not claimed the exact the location, shape, size and dimension of the connection between the primary and the auxiliary lens frames as that claimed by claims 1-4 of U.S. Patent No. 5,737,054, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears

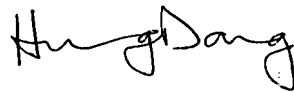
Serial Number: 08/963,299

Page 4

Art Unit: 2873

that these changes produce no functional differences and therefore would have been obvious.

16. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (703) 308-0550.



HUNG DANG

PRIMARY EXAMINER

TC 2800

3/99